

TMH/DAG:jam 01/26/06 464662 S98014E
PATENTAttorney Reference Number 7158-71253-11
Application Number 10/687,361**REMARKS**

Claims 4-13 and 34 were pending in this application. Claims 5-8 are cancelled without prejudice. Claims 4, 9 and 34 are amended. Applicants expressly reserve the right to pursue protection of any or all cancelled subject matter in one or more continuing applications.

No new matter is introduced by the foregoing amendments. Support for amended claim 4 can be found throughout the specification, for example at page 22, lines 9-19; see also, page 12, lines 20-23; page 14, lines 12-18 and page 33, lines 26 and 27. Claims 9 and 34 have been amended to correct matters of form, *i.e.*, to maintain proper antecedent basis for recited claim terms.

After entry of this amendment, **claims 4, 9-13, and 34 are pending in this application.** Consideration of the pending claims is requested.

In-Person Interview:

Applicants thank Examiners Yao and Canella for the courtesy of an in-person interview with their representative, Tanya M. Harding, on December 8, 2005. Also present at the interview was Cynthia Kanik as an observer on behalf of a licensee of the technology described in the application. During the interview, the rejections under 35 U.S.C. §112, 1st paragraph (written description) and 35 U.S.C. §102(b) were discussed. Applicants' representative had provided the Examiners with proposed claims prior to the interview, which claims are essentially identical to amended claims presented herein. The Examiners indicated that the proposed language appeared to overcome all of the pending rejections, but required that a formal response be filed.

Applicants have received the Examiner's interview summary, dated December 21, 2005. Applicants thank Examiner Yao for providing the summary, but note the following inaccuracies for the record:

The interview was in person at the Patent Office, rather than telephonic.

No copy of the interview summary was provided at the conclusion of the interview.

Applicants' representative understood that agreement had been reached in principal.

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Application Number 10/687,361Claim Rejections under 35 U.S.C. §112, 1st paragraph:

Claims 4, 8-13 and 34 have been rejected under 35 U.S.C. §112, 1st paragraph (written description) because, allegedly, "the claims are inclusive of a genus of fragments, variants, a polypeptide of SEQ ID NO: 2[; h]owever the written description in this case only sets forth Pin1 polypeptide (SEQ ID NO: 2) containing a WW domain and a PPIase domain" The Office concedes that "Pin1 polypeptide (SEQ ID NO: 2) . . . meets the written description provision of 35 U.S.C. §112."

Applicants traverse this rejection. Nevertheless, to facilitate prosecution of the application, claim 4 has been amended to recite, in relevant part: ". . . an antibody that selectively binds to a Pin1 protein having the amino acid sequence as set forth in SEQ ID NO: 2" As stated above, the Office indicates that this claim feature is sufficient to render claim 4 in compliance with the written description requirement. Claims 8-13 and 34 depend (directly or indirectly) from claim 4 and, therefore, these dependent claims also must satisfy the written description requirement. Accordingly, Applicants respectfully request that this rejection of claims 4, 8-13 and 34 be withdrawn.

Claim Rejections under 35 U.S.C. §102:

Claims 4, 8 and 9 have been rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Rahfeld *et al.* (*FEBS Lett.*, 352:180-184, 1994) as evidenced by Sequence Search ID No. S68520 (collectively "Rahfeld"). Rahfeld is said to "teach polyclonal antibodies for parvulin . . . , which has a high percentage homology to PPIase domain of Pin1." Moreover, Rahfeld allegedly "disclose[s] that the rabbit polyclonal antibodies . . . is (sic) used to monitor the levels of expression of PPIase in . . . *E. coli* K-12 cells . . . ,"

Applicants traverse this rejection. Nevertheless, to facilitate prosecution of the application, claim 4 has been amended to recite, in relevant part: ". . . an antibody that selectively binds to a Pin1 protein having the amino acid sequence as set forth in SEQ ID NO: 2" To properly anticipate a claim, a reference cited by the Office must teach or suggest all features of the rejected claims. Rahfeld does not teach or suggest the antibody recited in

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claim 4 and, by reference, in dependent claims 8 and 9. Thus, Rahfeld cannot anticipate claims 4, 8, or 9, and Applicants request that this rejection be withdrawn.

CONCLUSION

It is respectfully submitted that the present claims are in a condition for allowance. If any issues remain, the Examiner is requested to contact the undersigned attorney prior to issuance of the next Office action in order to arrange a telephone interview. It is believed that a brief discussion of the merits of the present application may expedite prosecution and allowance of the claims.

Respectfully submitted,

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